

## REMARKS

### OBJECTION TO THE SPECIFICATION

The Examiner has requested a substitute specification including the claims. The Applicants will provide a substitute specification that confirms to 37 CFR 1.52(1)(ii) where the top margin is at least 2 inches. The Applicants request that the Examiner place the objection in abeyance until issues of patentability have been resolved.

### CLAIM REJECTIONS- 35 U.S.C. § 102(e)

In the Office Action, Claims 1-3, 5-7, 11-21 and 23-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Williams et al., US Patent No. 5,977,964. Applicants respectfully disagree for the reasons provided below.

### Legal Principles

Certain well established principles must be observed in assessing whether or not an invention is patentable under 35 U.S.C. 102(a). First, the claims of a patent, which define the invention, are "to be construed in light of the specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966). During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be

arranged as required by the claim, although this is not an *ipsissimis verbis* test. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applying these principles to the invention as embodied in the present claims and to the Williams reference, the Applicants respectfully submit that a proper reading of the references fails to disclose or suggest the invention embodied in the present claims.

#### The Williams Patent

The Williams patent discloses a method and apparatus for automatically configuring a system based on a user's interaction and access time. Briefly, the Williams patent teaches an entertainment system that monitors user's inputs and updates the user's preference information accordingly. When the user uses the system again, the system will present the user with programming suggestions, which are determined based on the user's preference information.

#### Applying the Williams Reference to Claims 1-3, 5-7, 11-15 and 21-24

The Williams patent fails to teach or suggest limitations of the independent claims 1-3, 5-7, 11-21 and 23-30. Specifically, *inter alia*, the Williams patent fails to teach or suggest a "networked information monitor," which was referred to as "a fully configurable frame with one or more controls; the frame through which content is optionally presented" in the specification. The fully configurable frame utilized in accordance with the invention stands in contrast to present web browsers, which are branded by the browser vendor and which have limited means by which to alter the controls associated with the browser. (Specification, page 7, lines 21-26). The Applicants respectfully submit the Williams patent also fails to teach or suggest anything that can be reasonably interpreted to be a "networked information monitor," or NIM, of the present invention. Therefore, the rejections under 35 U.S.C. § 102(e) cannot stand because the Williams patent does not teach all limitations of the rejected claims.

It appears that the Examiner's Action has interpreted the term "networked information monitor" to include "user profiles" or "user preference information stored within the user profiles" of the Williams reference. However, this interpretation is unwarranted. The

specification of the present application clearly specifies that a "networked information monitor" or "NIM" refers to "a fully configurable frame with one or more controls; the frame through which content is optionally presented." The fully configurable frame utilized in accordance with the invention stands in contrast to present web browsers, which are branded by the browser vendor and which have limited means by which to alter the controls associated with the browser. (Specification, page 7, lines 21-26).

During examination, the claims must be interpreted as broadly as their terms *reasonably* allow. This means that the words of the claim must be given their plain meaning *unless applicant has provided a clear definition in the specification.* In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). In this case, interpreting the term "networked information monitor" to be equivalent to "user preference information" or "user profiles" of the Williams invention is unreasonable. The Applicants respectfully submit that "user preference information" or "user profiles," have *never* been called a "networked information monitor," and that a person of ordinary skill in the art would not have called a "networked information monitor" a "user preference information" or "user profile." Indeed, in the present application, the Applicants also use the terms "user profiles" and "user profile database," but these terms are not used to refer to a NIM. For example, the instant specification states that "the processed user profile includes a reference to a home NIM." (Specification, page 9, lines 9-10)." Thus, a NIM is by inference distinct from a user profile.

The Applicants' undersigned representative has performed a Google search ([www.google.com](http://www.google.com)) on the Internet for the term "networked information monitor," but did not find any reference that uses the term to refer to user preference. The Examiner is invited to perform the same Google search and other searches on the Internet using different search engines. Furthermore, the term "networked information monitor" is clearly defined in the specification and therefore at the very least the term should be given a meaning consistent with the meaning defined therein. A "user profile" or "user preference information" is clearly not consistent with "a fully configurable frame with one or more controls; the frame through which content is optionally presented."

With respect to claim 1, the claimed invention includes the steps of: identifying a definition of a NIM, defining a NIM frame for said NIM using said definition, retrieving content for said NIM, and placing said content in a NIM viewer defined by said frame. Applicants respectfully submit that the Williams patent does not teach the claimed invention because the Williams patent does not teach or suggest a NIM or a definition that defines a NIM frame.

Even if Williams teaches a NIM, Williams does not teach a frame that defines a NIM viewer, which is claimed in claim 1. Thus, there is no way that Williams can perform the steps of independent claim 1.

At least for the reasons above, Applicants respectfully submit that claim 1 is allowable. Claims 2-3, 5-7, 11-15 are also allowable for being dependent claims of claim 1.

With respect to independent claim 21, the same reasons given for claim 1 apply, as the claimed aspects are not found in Williams. Claims 22-24 are also allowable for being dependent claims of claim 21.

#### Applying the Williams Reference to Claims 16-20 and 25-27

The Examiner's Action rejected claims 16-20 and 25-27 for reasons similar to those applied to claims 1-3, 5-7, and 11-15. The Applicants respectfully traverse.

Independent claim 16, which is directed to "a method of altering a Networked Information Monitor (NIM)," includes the limitations of "receiving a message at a NIM, said message specifying a configurable feature of said NIM"; and "altering said NIM in accordance with said configurable feature of said message."

Applicants respectfully submit that at least some of these claim limitations may not be co-extensive with those of claims 1-3, 5-7, and 11-15. Accordingly, Applicants respectfully submit that the Examiner's Action failed to show how these limitations are anticipated by the Williams reference.

Even if these limitations are found in claims 1-3, 5-7 and 11-15, they are not taught or suggested by the Williams reference. As discussed in the previous section, the Williams

reference does not teach or suggest a NIM. Hence, there is no way the Williams reference could have taught the limitations of claim 16.

Accordingly, Applicants respectfully submit that claim 16 is allowable. Claims 17-20 are also allowable as being dependent claims of claim 16.

With respect to claims 25-27, the same reasons given for claims 16-20 apply.

#### Applying the Williams Reference to Claims 28-30

The Examiner's Action rejected claims 28-30 for reasons similar to those applied to claims 1-3, 5-7, and 11-15. The Applicants respectfully traverse.

Independent claim 28, which is directed to "a computer readable memory to direct a computer to function in a specified manner," includes "a first executable module to facilitate the activation of a set of NIMs on a client device controlled by a user, each NIM of said set of NIMs including a configurable NIM frame surrounding a NIM viewer; a second executable module to retrieve a set of addressed Internet content for said set of NIMs, said set of addressed Internet content including individually packaged content for each NIM viewer associated with said set of NIMs, said individually packaged content residing at a predetermined address; and a third executable module to load said addressed Internet content into each NIM of said set of NIMs."

Applicants respectfully submit that at least some of these claim limitations may not be co-extensive with those of claims 1-3, 5-7, and 11-15. Accordingly, Applicants respectfully submit that the Examiner's Action failed to show how these limitations are anticipated by the Williams reference.

Even if these limitations are found in claims 1-3, 5-7 and 11-15, they are not taught or suggested by the Williams reference. For instance as discussed in the previous section, the Williams reference does not teach or suggest a NIM or a set of NIMs for a user. Hence, there is no way the Williams reference could have taught the limitations of claim 28.

Accordingly, Applicants respectfully submit that claim 28 is allowable. Claims 29-30 are also allowable as being dependent claims of claim 28.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

The Examiner's Action rejected claims 4 and 22 under 35 U.S.C. 103(a) as being unpatentable over Williams et al. in view of Bayeh (USPN 6,012,098). The Examiner's Action further rejected claims 8-10 as being unpatentable over Williams et al. in view of Ferrel (USPN 6,230,173). Applicants respectfully traverse and request the Examiner to consider the following remarks.

Legal Principles

Certain well established principles must be observed in assessing whether or not an invention is patentable under 35 U.S.C. 103(a). First, the claims of a patent, which define the invention, are "to be construed in light of the specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966). The "differences between the prior art and the claims at issue are to be ascertained." Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Moreover, it is elementary that the claimed invention must be considered as a whole in deciding obviousness. Litton Industrial Products, Inc. v. Solid State Systems Corp., 755 F. 2d 158, 164, 255 USPQ 34, 38 (Fed. Cir. 1985). The prior art as a whole must be considered, and those portions of the prior art arguing against or teaching away from the claimed invention must be considered. Bausch & Lomb, Inc v. Barnes-Hind/Hydrocurve, Inc., 796 F. 2d 443, 448, 230 USPQ 416, 420 (Fed. Cir. 1986), In re Hedges, et al., 783 F. 2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986). Moreover, "[t]he mere fact that the prior art could be ... modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis supplied.) In re Gordon, 733 F. 2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) which cites with approval Carl Schneck, A. G. v. Nortron, Corp., 713 F. 2d 782, 787, 218 USPQ 698, 792 (Fed. Cir. 1983) and In re Sernaker, 702 F. 2d 989, 995-96, 217 USPQ 1, 6-7 (Fed. Cir. 1983), both citing In re Imperato, 486 F. 2d 585, 587, 179 USPQ 730, 732 (CCPA 1973). In accord, In re Laskowski, 871 F. 2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

Establishing a *prima facie* case of obviousness requires that the prior art give reason or motivation to make the claimed invention. In re Dillon, 919 F. 2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc), cert denied, 500 U.S. 904 (1991). (Emphasis supplied.) Second, there must be a reasonable expectation of success. Third, the references when combined must teach or suggest all the claim limitations. MPEP 2141. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (1991).

The mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. MPEP 2143 (emphasis supplied).

Finally, it is impermissible to first ascertain factually what the inventor did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct the invention from such prior art. Panduit Corp. v. Dennison Manufacturing Co., 774 F. 2d 1082, 1092, 227 USPQ 337, 343 (Fed. Cir. 1985). (Emphasis supplied.)

Applying these principles to the invention as embodied in the present claims and to the Williams, Bayeh and Ferrel references, the Applicants respectfully submit that a proper reading of the references fails to disclose or suggest the invention embodied in the present claims.

#### The Bayeh Patent

The Bayeh reference teaches a method of using servlets to isolate the retrieval of data from the rendering of the data into presentation format. In essence, the invention is directed to using one servlet to perform data retrieval, and another servlet to perform data rendering. The data servlet retrieves data and sends the output to the rendering servlet. This output data stream can be formatted using XML (Extensible Markup Language).

The Ferrel Patent

The Ferrel reference teaches a Multimedia Publishing System (MPS). Independent Content Providers (ICPs) supply the system with projects (e.g., stories, publications and newsletters). The MPS takes the projects produced by the publishers and make them accessible to users on the Microsoft Network. Project contents and their layouts are stored as separate objects in a publication site (e.g., Microsoft Network) so that many different pieces of content can be viewed with the same appearance.

Applying the Williams and Bayeh References to Claims 4 and 22

In order to establish a *prima facie* case of obviousness, controlling authority mandates the prior art give reason or motivation to make the claimed invention. Furthermore, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The Examiner's Action indicated that Williams discloses a method for presenting distributable computer readable media but does not disclose a definition that is in XML format. The Examiner's Action further indicated that the Bayeh reference discloses a document definition written in XML format. As a justification for the combination, the Examiner's Action indicated that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide an isolation technique which uses widely accepted programming techniques and data formatting notations as stated in Bayeh.

Applicants respectfully submit this is the wrong application of the law, which requires that the prior art given reason or motivation to make the *claimed invention*. The Examiner's Action merely repeated a section of Bayeh, which gives reason or motivation to make the Bayeh's invention, and fails to indicate the reason or motivation to make the *claimed invention* by combining this teaching with the teachings of Williams.

Accordingly, a *prima facie* case of obviousness has not been established for claim 4, which is therefore allowable. As an alternative ground for allowance, claim 4 is a dependent claim of claim 1, which is allowable.

With respect to claim 22, the same reasons given for claim 4 apply.

Applying the Williams and Ferrel References to Claims 8-10

With respect to claim 8, the Examiner's Action indicated that Williams discloses a method for presenting distributable computer readable media but does not disclose a step of identifying a definition including a frame specification with a title bar definition. The Examiner's Action further indicated that the Ferrel reference discloses identifying a definition including a frame specification with a title bar definition. As a justification for the combination, the Examiner's Action indicated that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ferrel with Williams to provide a separation of design from content and increased flexibility for presenting content to subscribers or users as stated in Ferrel.

Applicants respectfully submit this is the wrong application of the law, which requires that the prior art given reason or motivation to make the *claimed invention*. The Examiner's Action merely repeated a section of Ferrel, which gives reason or motivation to make the Bayeh's invention, and fails to indicate the reason or motivation to make the *claimed invention* by combining this teaching with the teachings of Williams.

Accordingly, a *prima facie* case of obviousness has not been established for claim 8, which is therefore allowable. As an alternative ground for allowance, claim 8 is a dependent claim of claim 1, which is allowable.

With respect to claim 9-10, the same reasons given for claim 4 apply.

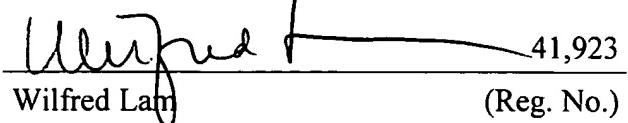
CONCLUSION

In light of the above, Applicants respectfully submit that the pending claims are allowable. Applicants believe a telephone interview would help clarify issues of the present application and advance prosecution of this case, and respectfully request the Examiner to contact the undersigned attorney to set up a mutually convenient time for a telephone interview.

App. No. 09/558,925  
Response dated: January 13, 2004  
Reply to Office Action of August 13, 2003

Date January 13, 2004

Respectfully submitted,

  
Wilfred Lam 41,923  
(Reg. No.)

Innovation Management Sciences  
47787 Fremont Boulevard  
Fremont, California 94538  
(510) 979-3324

Enclosure